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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/509,402

Filing Date: September 23, 2004

Appellant(s): JAAKOLA, MIKAEL

Alfred A. Fressola
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/19/2008 appealing from the Office action
mailed 09/26/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-6, 8-16, and 23-24 stands rejected under 35 U.S.C. 103(a) over Kanesaka et al. (US Patent No.: 6,825,830) in view of Marshall (US Pub. No.: 2002/0095538), and further in view of Morton (US Pub. No.: 2002/0178631).

Claims 17-18, 22, and 25-26 stands rejected under 35 U.S.C. 103(a) over Marshall (US Pub. No.: 2002/0095538) in view of Kanesaka et al. (US Patent No.: 6,825,830) and further in view of Morton (US Pub. No.: 2002/0178631).

Claim 7 stands rejected under 35 U.S.C. 103(a) over Kanesaka et al. (US Patent No.: 6,825,830) in view of Marshall (US Pub. No.: 2002/0095538), and further in view of Morton (US Pub. No.: 2002/0178631) as applied to claim 1 above, and further in view of Adams et al. (US Pub. No.: 2004/0240163).

Claim 19-21 stands rejected under 35 U.S.C. 103(a) over Marshall (US Pub. No.: 2002/0095538) in view of Kanesaka et al. (US Patent No.: 6,825,830), and further in view of Morton (US Pub. No.: 2002/0178631) as applied to claim 17 above, and further in view of MacKey (US Patent. No.: 5,956,630).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------------------------|-----------------|-------------------|
| U.S. Patent Number: 6,825,830 | Kanesaka et al. | November 30, 2004 |
| U.S. Pub. Number: 2002/0095538 | Marshall | July 18, 2002 |
| U.S. Pub. Number: 2002/0178631 | Morton | December 05, 2002 |
| U.S. Patent Number: 5,956,630 | Mackey | Sep. 21, 1999 |
| U.S. Pub. Number: 2004/0240163 | Adams et al. | December 02, 2004 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-16, and 23-24 stands rejected under 35 U.S.C. 103(a) over Kanesaka et al. (US Patent No.: 6,825,830) in view of Marshall (US Pub. No.: 2002/0095538), and further in view of Morton (US Pub. No.: 2002/0178631).

Claims 17-18, 22, and 25-26 stands rejected under 35 U.S.C. 103(a) over Marshall (US Pub. No.: 2002/0095538) in view of Kanesaka et al. (US Patent No.: 6,825,830) and further in view of Morton (US Pub. No.: 2002/0178631).

Claim 7 stands rejected under 35 U.S.C. 103(a) over Kanesaka et al. (US Patent No.: 6,825,830) in view of Marshall (US Pub. No.: 2002/0095538), and further in view of Morton (US Pub. No.: 2002/0178631) as applied to claim 1 above, and further in view of Adams et al. (US Pub. No.: 2004/0240163).

Claim 19-21 stands rejected under 35 U.S.C. 103(a) over Marshall (US Pub. No.: 2002/0095538) in view of Kanesaka et al. (US Patent No.: 6,825,830), and further in view of Morton (US Pub. No.: 2002/0178631) as applied to claim 17 above, and further in view of MacKey (US Patent. No.: 5,956,630).

These rejections are set forth in a prior Final Office Action, mailed on 09/26/2007 as followed.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-16, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanesaka et al. (U.S. Patent No.: 6,825,830, hereinafter, "Kanesaka") in view of Marshall (Pub. No.: US 2002/0095538) and further in view of Morton (U.S. Pub. No.: 2002/0178631).

Regarding claims 1 and 23, Kanesaka teaches a personal telecommunication device (see figures 1&2, read on the combination of first 100 and second 101 information process devices), comprising:

a keypad for allowing a human user to input information to the personal telecommunication device (see figure 1, first information process device 100 is included keypad), and

a display for displaying information to a human user of the personal telecommunication device (see figure 1, second information process device 101 is included a display 120),

two mechanically separate structural parts, of which a first part is a keypad part (read on first information process device 100) that comprises the keypad (see figure 1, first information process device is included keypad), and a second part is an amulet (read on second information process device 101) that comprises the display (see figure 1, second information process device is included a display 120),

a short distance communication link between said keypad part and said amulet (see figure 1, first information process device 100, second information process device 101, col.4, ln.42-47), and

said amulet further comprising a hanging arrangement for allowing said amulet to be worn on the torso of a human user (see figure 1, neckband, col.4, ln.60-64).

It should be noticed that Kanesaka fails to teach the amulet comprises a microphone and speaker for setting up an audio interface between the personal telecommunication device and a human user. However, Marshall teaches such

features (see figure 8, the module 200 is wearing around the user's neck comprises a MIC 206, speaker 208, col.5, [0054]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Marshall into view of Kanesaka in order to record and retrieve information in the memory as well as communicating via voice recognition with other device as suggested by Marshall at col.5, [0054].

Kanesaka and Marshall, in combination, fails to teach the display is directed away from the human user to allow the human user to self-express himself/herself via the display of the amulet. However, Morton teaches such features (see figure 3, display 28 is direct away from the user who wearing the display 28. The display 28 can be view by the doctor, [0029]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Morton into view of Kanesaka and Marshall in order to easily access the user's medical information in the event of emergency as suggested by Morton at [0006].

Regarding claim 2, Kanesaka further teaches said keypad part (read on first information process device 100 of figure 1) comprises a main processor (see figure 2, controller 200) adapted to control the operation of the personal telecommunication device (figure 2, first device 100), as well as a radio transceiver (figure 2, transceiver 201) coupled to said main processor (controller 200) for arranging bidirectional radio

communication between the personal telecommunication device and a digital cellular radio network (see figures 1&2, base station 102, col.4, ln.18-52).

Regarding claim 3, Kanesaka further teaches the short distance communication link between said keypad part and said amulet is a unidirectional link from said keypad part to said amulet (see figure 1, col.4, ln.27-32).

Regarding claim 4, after combine, Marshall and Kanesaka teaches the claimed limitations. Marshall teaches said amulet comprises an input device (see figure 8, keypad 212), and Kanesaka teaches the short distance communication link between said keypad part and said amulet is a bidirectional link adapted to convey input information from said input device in said amulet to said main processor in said keypad part (see figures 1&2, first device 100, second device 101, controller 200, controller 210, col.4, ln.18-52).

Regarding claim 5, Kanesaka further teaches said keypad part comprises a microphone and an electro acoustic transducer for setting up an audio interface between the personal telecommunication device and a human user (see figure 2, first device 100, speaker 204, MIC 205).

Regarding claim 6, Marshall further teaches said amulet comprises another input device that comprise at least one pressable key (see figure 8, keypad 212).

Regarding claim 8, Kanesaka further teaches said amulet comprises a power switch for switching an operating power on and off (see figure 2, sub switch 213 is switch second device on/off).

Regarding claim 9, Kanesaka further teaches said amulet comprises a main processor adapted to control the operation of the personal telecommunication device, and said keypad part comprises a radio transceiver coupled to said main processor through a bidirectional short distance communication link between said keypad part and said amulet for arranging bidirectional radio communication between the personal telecommunication device and the digital cellular radio network (see figures 1&2, controllers 200, 210, first device 100, second device 101, col.4, ln.18-67).

Regarding claim 10, Marshall further teaches said amulet comprises a main processor adapted to control the operation of the personal telecommunication device, as well as a radio transceiver coupled to said main processor for arranging bidirectional radio communication between the personal telecommunication device and a digital cellular radio network (see figure 11, col.5, [0056], the module 240 should be include a controller and transceiver).

Regarding claim 11, Kanesaka further teaches the short distance communication link between said keypad part and said amulet is a unidirectional link from said keypad part to said amulet (see figure 1, col.4, ln.27-32).

Regarding claim 12, Marshall further teaches a third mechanically separate structural part (1001), which is a display part and comprises a display that is larger than the display in said amulet, and a short distance communication link between said display part and the other parts of the personal telecommunication device (see figure 2, figure 8, display 82, display 210, it is clearly show that the display 82 is larger than the display 210 in the module 200).

Regarding claim 13, Kanesaka further teaches said keypad part is a mobile station of a cellular radio network and as such functionally completely independent of said amulet, said mobile station comprises a general purpose short distance transceiver for setting up and maintaining short distance communication connections with other devices, and said mobile station is adapted to transmit a copy of certain information destined to a display in said mobile station to said amulet through said general purpose short distance transceiver (see figures 1&2, controllers 200, 210, first device 100, second device 101, col.4, ln.18-67).

Regarding claim 14, Marshall further teaches said amulet is adapted to communicate with other devices than said keypad Part (see figure 2, module 10, headset 60).

Regarding claim 15, Marshall further teaches said amulet comprises a connector for connecting it into a receptive socket in another device (see figure 1, module 10, I/O 18, entertainment 30).

Regarding claim 16, Kanesaka further teaches said amulet is mechanically incompatible with said keypad part (see figure 1, device 101 can not couple with device 100).

Regarding claim 24, Kanesaka further teaches said first pad comprises a main processor adapted to control the operation of the personal telecommunication device, as well as a radio transceiver coupled to said main processor for arranging bidirectional radio communication between the personal telecommunication device and a digital cellular radio network (see figure 1 and figure 2, device 100).

3. Claims 17-18, 22, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (Pub. No.: US 2002/0095538) in view of Kanesaka et al. (U.S. Patent No.: 6,825,830, hereinafter, "Kanesaka") and further in view of Morton (U.S. Pub. No.: 2002/0178631).

Regarding claims 17 and 25, Marshall teaches an amulet part for a personal telecommunication device (see figures 1&2, 8, module 200), comprising:

a microphone and an electro acoustic transducer for setting up an audio interface with a user of the amulet (see figure 8, the module 200 is wearing around the user's neck comprises a MIC 206, speaker 208, col.5, [0054]),

a transceiver for establishing a communication between the microphone and electro acoustic transducer and the personal telecommunication device (see figure 2, wireless interface 18 using RF signal to permit communication to and from module 10, and it is obvious that it is included a transceiver, [0024]), and

a hanging arrangement for allowing the amulet part to be worn on the torso of the user (see figure 1).

It should be noticed that Marshall fails to teach a display for displaying information to a human user of the personal telecommunication device, and a transceiver for receiving information to be presented in the display from another part of the personal telecommunication device. However, Kanesaka teaches a display for displaying information to a human user of the personal telecommunication device (see figure 1, second information process device 101 is included a display 120), and a transceiver for receiving information to be presented in the display from another part of

the personal telecommunication device (see figure 2, transceiver 211 receive the information from transceiver 209 and display information on display unit 212).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kanesaka into view of Marshall in order to improve user friendliness when confirming the content of a display displayed by the device as suggested by Kanesaka at col.1, ln.45-52.

Marshall and Kanesaka, in combination, fails to teach the display is directed away from the human user to allow the human user to self-express himself/herself via the display of the amulet. However, Morton teaches such features (see figure 3, display 28 is direct away from the user who wearing the display 28. The display 28 can be view by the doctor, [0029]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Morton into view of Marshall and Kanesaka in order to easily access the user's medical information in the event of emergency as suggested by Morton at [0006].

Regarding claim 18, Marshall further teaches said hanging arrangement comprises a string with two ends of which are attached to a body of the amulet part so that the string constitutes a loop (see figure 1, band 14, [0023]).

Regarding claim 22, Marshall further teaches memory means for storing graphical information that is adapted to be shown on said display as a logo (see memory 202, display 210).

Regarding claim 26, Marshall further teaches said means for allowing the

amulet part to be worn comprises a string with two ends attached to a body of the amulet part so that the string constitutes a loop (see figure 8).

4. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanesaka et al. (U.S. Patent No.: 6,825,830, hereinafter, "Kanesaka") in view of Marshall (Pub. No.: US 2002/0095538), and further in view of Morton (U.S. Pub. No.: 2002/0178631) as applied to claim 1 above, and further in view of Adams et al. (Pub. No.: US 2004/0240163, hereinafter, "Adams").**

Regarding claim 7, Kanesaka, Marshall, and Morton, in combination, fails to teach touch screen display. However, Adams teaches such feature (see figure 1, display 100, col.2, [0019]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Adam into view of Kanesaka, Marshall, and Morton in order to easily input the data by hand.

5. **Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (Pub. No.: US 2002/0095538) in view of Kanesaka et al. (U.S. Patent No.: 6,825,830, hereinafter, "Kanesaka"), and further in view of Morton (U.S. Pub. No.: 2002/0178631) as applied to claim 17 above, and further in view of Mackey (U.S. Patent No.; 5,956,630).**

Regarding claim 19, Marshall, Kanesaka, and Morton, in combination, fails to teach an electro acoustic transducer at the end of a cord extending from said body of

the amulet part, a certain length of which cord is attached to said string. However, Mackey teaches such features (see figure 1, transducer 20, close loop 25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Mackey into view of Marshall, Kanesaka, and Morton in order to comfortably worn the portable radio by an individual as suggested by Mackey at col.1, ln.58-63.

Regarding claim 20, Mackey further teaches two electro acoustic transducers, each transducer being located at the end of a cord extending from said body of the amulet part so that a certain length of each cord is attached to said string and between said certain length and the transducer at the end of the cord each cord hangs free from attachments to said string (see figure 1, transducer 20, close loop 25).

Regarding claim 21, Mackey further teaches a receiver for receiving radio broadcasts (see figure 1, radio receiver 14).

(10) Response to Argument

(I) Appellant's first argument:

In page 6 of the Appeal Brief, Appellant argues that Examiner has not established a *prima facie* case of obviousness to combined Kanesaka in view of Marshall and further in view of Morton as recited in claims 1, 17, 23, and 25.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. It appears applicant is attacking individual merits of Kanesaka, Marshall, and Morton and concludes that there is no impetus to combine them.

However, the 103 rejections are considered the combination of references as a whole. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Marshall and Morton as a secondary teaching is not to combine its structural features into Kanesaka, but rather to use the teaching of Marshall and Morton to combine with the teaching of Kanesaka to meet the claimed invention. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.1992). It has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

In this case, Kanesaka, Marshall, and Morton are in the same field of the appellant's endeavor. As admitted by Appellant in page 5, Kanesaka teaches an information processing system having a first information processing device 100 (wireless mobile phone 100) for receiving and sending data information from and to base station 102 and a second information processing device 101 (second display device 101) for sending and receiving the data information from and to the first

information processing device 100 (see figure 1, first information processing device 100, second information processing device 101, base station 102). In addition, the second information processing 101 can be hanging on the person's neck to communicate with other devices.

Marshall teaches a wireless personal entertainment media module 10 communicates with other wireless devices (see figure 2, personal entertainment media module 10, [0030]). In addition, the wireless personal entertainment media module 10 can be hanging on the person's neck to communicate with other devices.

Morton teaches a communication medical information storage device store the user personal profiles and display the user information to the other people (see figures 2 & 4). In addition, the communication medical information storage device can be hanging on the person's neck (see figure 3).

Since Kanesaka, Marshall, and Morton are the same environment of the wireless communication system that having the personal devices which includes the display for displaying the information to the users and it can be hanging on the person's neck. Therefore, they are the same field of appellant' endeavor. For the sake of argument, even if Kanesaka, Marshall, and Morton are not in the field of appellant's endeavor as alleged by appellant (which Examiner disagrees as set forth above), then Kanesaka, Marshall, and Morton is reasonably pertinent to the particular problem with which the appellant was concerned. Therefore, there is an existing a strong *prima facie* case of obviousness under 35 U.S.C 103, and proper to combine Kanesaka, Marshall, and Morton.

(II) Appellant's second argument:

In pages 5-6 of the Appeal Brief, Appellant argues that "there would be absolutely no reason for modifying the second information processing device 101 which is shown only with a display to further include an additional microphone and speaker".

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. It is a common knowledge in the art that to have a wireless (e.g. Bluetooth) headset integrated with a microphone and speaker to wirelessly communicate with mobile phone in order to provide a hand-free operation. In this case, it is clearly seen that the second information processing device 101 can be integrated with microphone and speaker to communicate with the first information processing device 100 (mobile phone) to provide a hand-free operation. Therefore, Kanesaka system as shown in figure 1 can be having two microphones and two speakers.

(III) Appellant's third argument:

In pages 6-7 of the Appeal Brief, Appellant argues that Morton does not suggest the displaying of information to third parties in order to allow the user of the display to self-express himself/herself.

In response to appellant's arguments, Examiner respectfully disagrees with the appellant's argument. It is noted that appellant's own specification is disclosed in page 11, lines 18-22 defined self-express himself/herself such as "self-expression means so that a person passing by or otherwise looking at the user could easily see the text or image that appears on the display". In this case, Morton teaches a medical information device which includes a display device for displaying the user

personal information such as user's name, date of birth, and medical condition to the doctors or other medical personnel (see figure 2, [0029]) who may pass by or look at the device to see (or be "expressed") information relevant to the care of that patient. Therefore, Morton read on claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/TUAN A PHAM/

Tuan Pham

August 10, 2008
Examiner, Art Unit 2618

/Matthew D. Anderson/

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